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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/663,542	09/15/2000	Mark D. Fidock	PC10349AGPR	3854

7590 12/17/2002  
Gregg C Benson  
Pfizer Inc  
Patent Department  
MS 4159 Eastern Point Road  
Groton, CT 06340

EXAMINER

KAUSHAL, SUMESH

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 12/17/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/663,542

Applicant(s)

FIDOCK ET AL.

Examiner

Sumesh Kaushal Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-16,19-22 and 24-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-4,6-16,19-22 and 24-27 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

Preliminary amendment filed on 03/02/01 has been acknowledged.

► *If the claims are amended, added and/or canceled in response to this office action the applicants are required to follow Amendment Practice under 37 CFR § 1.121 (<http://www.uspto.gov>) and A CLEAN COPY OF ALL PENDING CLAIMS IS REQUESTED.*

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 13 15 and 21, drawn to a PDEXV polypeptide, classified in class 530, subclass 350.
- II. Claims 2-4, 6-7, 14, 16 and 22 are drawn to a nucleic acid sequence, expression vector and host cells, classified in class 435, subclass 325.
- III. Claims 8-12 and 19-20, drawn to an assay method for identifying an agent that can affect PDEXV activity, and PDEXV agonist and antagonist, classified in class 435, subclass 7.1.
- IV. Claim 16 and 27, drawn to pharmaceutical composition for the treatment of a disease or condition associated with PDEXV, classified in class 514, subclass 2.
- V. Claims 24-26, drawn to an assay method for identifying an agent that can affect PDE1B2 expression wherein the agent interacts with PDEXV nucleotide sequences, classified in class 435, subclass 6.

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The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups I (Polypeptide) and II (Nucleic acid) are distinct. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the PDEXV polypeptide and PDEXV nucleic are structurally and functionally distinct products. For example, the polypeptides are biologically active compounds, whereas the nucleic acid requires an expression vector and host cells to produce the gene product. Thus these inventions are distinct and are of separate uses.

Inventions of Groups III and V are distinct. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case invention of group III requires the identification of an agent that interacts with PDEXV polypeptide (e.g antibody), whereas the invention of group V requires the identification of an agent that interacts with a PDEXV nucleic acid sequence (e.g. DNA binding protein). Thus these inventions are distinct and are of separate uses.

Inventions of Groups III and V are distinct from the method of Group IV. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case invention of Group IV encompasses the use of a protein based therapeutic composition in vivo, whereas the invention of Group III and V requires identification

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of agents that interacts with PDEXV protein and DNA respectively in-vitro. Thus these inventions are distinct and are of separate uses.

In addition, the inventions of Group I and II are distinct from the inventions of Groups III, IV and V since the polypeptides (group-I) and nucleic acid (group-II) can also be used to make antibodies and hybridizations probes respectively. Thus these inventions are distinct and are of separate uses.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sumesh Kaushal Ph.D. whose telephone number is 703-305-

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6838. The examiner can normally be reached on Mon-Fri. from 9AM-5PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yucel Irem Ph.D. can be reached on 703-305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-8724 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

*S. Kaushal*

Patent examiner



JEFFREY FREDMAN  
PRIMARY EXAMINER